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10/017,947	12/07/2001	L. Michael Maritzen	Sony-00700	7595

7590

10/20/2003

Valley Oak Law
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San Jose, CA 95138

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,947

Applicant(s)

MARITZEN ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 1, 14, 29, 41, and 47 are amended.
 - Claims 45 and 46 are canceled.
 - Claims 1-44 and 47 have been considered.
3. Examiner withdraws objection to the drawings and specification due to correction by the applicant.

Response to Arguments

4. Applicant's arguments filed on 30 July 2003, with respect to claims 1, 14, 29, 41, and 47 have been considered but are moot in view of the new ground(s) of rejection. Examiner would like to emphasize that Ginter reference clearly teaches alleged inventive steps of claims mentioned above. Ginter teaches the steps of usage of content and how it is metered and charged for in the VDE at the user side utilizing a local processing to calculate a charge amount (See Ginter column 33, lines 36-65, column 36, lines 44-68, column 37, lines 1-31, column 40, lines 62-68, and column 41, lines 1-68).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. The term "immediately" in claim 1 is a relative term, which renders the claim indefinite. The term "immediately" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "immediately" needs to be clarified. Therefore, independent claim 1 is rejected. Additionally dependent claims 2-13, being dependent on claim 1 are rejected as well.

Art Unit: 3621

7. Additionally in claim 1, the use of "configured to..." phrase makes the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in the claim in order achieve the desired results expressed in the "configured to..." phrase. In independent claim 1, the "wherein..." phrases makes the claim indefinite and unclear in that neither means nor interrelationship of means are set forth in the claim in order to achieve the desired results expressed in the "wherein..." phrases.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,892,900 to Karl L. Ginter et al. in view of U.S. Patent No. 6,025,868 to James Russo.

10. As per claim 1, Ginter clearly discloses a transaction system comprising:

- a transaction device having a storage device wherein the transaction device is configured for interfacing with a user;
- embedded content residing within the storage device of the transaction device (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, and column 5, lines 1-41),
- wherein the embedded content is immediately available to the user and wherein the transaction device is configured to calculate a charge amount in response to usage of the embedded content wherein the charge amount is locally logged within the transaction device (See Ginter column 33, lines 36-65, column 36, lines 44-68, column 37, lines 1-31, column 40, lines 62-68, and column 41, lines 1-68).

Art Unit: 3621

11. What is not specifically clear is the immediate availability of the content to the customer.

However, both Russo and Ginter clearly disclose similar systems of content distribution to the end user and making such content available to the end user without delay and charging happens after the content has been viewed or utilized substantially (See Russo column 5, lines 8-40, column 7, lines 43-63, column 10, lines 20-57, and column 11, lines 1-13). Russo is clear that content is available to the end user and the charges and accounting of such transaction happens within the end user's device (See Russo column 6, lines 16-61 and column 10, lines 19-57). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a more reliable and secure distribution system of content that the end user has more control on what they are paying for view before buy or try and buy systems, which are widely used in the digital works distribution industry. This actually speeds up the transaction in two fronts, first the end user is sure of what digital work is being obtained and second the accounting takes place at the end user device.

12. As per claim 2-13, Ginter and Russo disclose all the limitations of claim 1, further;

Ginter discloses,

- a backend module configured for tracking a location of the embedded content (See Ginter column 4, lines 44-68),
- wherein the embedded content contains audio data (See Ginter column 9, lines 3-20, column 27, lines 44-68, and column 32, lines 24-68),
- wherein the embedded content contains visual data (See Ginter column 27, lines 44-68, and column 32, lines 24-68),
- wherein the embedded content contains a financial balance of the user (See Ginter column 11, lines 22-68, and column 12, lines 1-65),
- wherein the embedded content contains credit data of the user (See Ginter column 33, lines 36-65, and column 35, lines 13-53),
- wherein the embedded content contains a location history of the embedded content (See Ginter column 4, lines 5-68, and column 6, lines 14-29, and column 45, lines 15-68),

Art Unit: 3621

- wherein the embedded content contains a current location of the embedded content (See Ginter column 14, lines 25-48, and column 45, lines 15-68),
- wherein the embedded content contains encryption information (See Ginter column 12, lines 3-44),
- wherein the embedded content contains ownership information related to the embedded content (See Ginter column 10, lines 23-31, and column 135, lines 20-34),
- wherein the embedded content contains textual data (See Ginter column 23, lines 21-35),
- wherein the embedded content contains graphical data (See Ginter column 23, lines 21-35).

13. As per claims 14, 29, and 47, Ginter discloses a method and a computer-readable medium comprising;

- receiving embedded content within a transaction device;
- locally storing a charge amount within the transaction device for usage of the embedded content;
- providing a local charge account within the transaction device for the charge amount;
- utilizing the embedded content in response to the local charge account;
- verifying a validity of the local charge account with a remote device after utilizing the embedded content.
- requesting a payment corresponding to the charge amount from a remote device subsequent to using the embedded content on the transaction device;
- discontinuing use of the embedded content in response to denial of payment.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 33, lines 36-65, column 36, lines 44-68, column 37, lines 1-31, column 40, lines 62-68, and column 41, lines 1-68).

14. What is not specifically clear by Ginter is the utilization or availability of the content to the end user before the finalization of the verification of validity of charges. However, both Russo and Ginter clearly disclose similar systems of content distribution to the end user and making such content available

Art Unit: 3621

to the end user without delay and charging happens after the content has been viewed or utilized substantially (See Russo column 5, lines 8-40, column 7, lines 43-63, column 10, lines 20-57, and column 11, lines 1-13). Russo is clear that content is available to the end user and the charges and accounting of such transaction happens within the end user's device (See Russo column 6, lines 16-61 and column 10, lines 19-57). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a more reliable and secure distribution system of content that the end user has more control on what they are paying for view before buy or try and buy systems, which are widely used in the digital works distribution industry. This actually speeds up the transaction in two fronts, first the end user is sure of what digital work is being obtained and second the accounting takes place at the end user device.

15. As per claims 15 and 30, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- encrypting the embedded content upon receiving the embedded content within the transaction device (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 12, lines 3-44, column 40, lines 62-68, and column 41, lines 1-68).

16. As per claims 16 and 31, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- wherein utilizing the embedded content further comprising decrypting the embedded content (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 12, lines 3-44, column 40, lines 62-68, and column 41, lines 1-68).

17. As per claims 17 and 32, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Art Unit: 3621

Ginter discloses,

- encrypting the embedded content in response to not verifying the authorization (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 40, lines 62-68, column 41, lines 1-68, and column 48, lines 34-64).

18. As per claims 18 and 33, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- transmitting a payment from the transaction device to a vendor based on the embedded content (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 48, lines 34-64).

19. As per claims 19 and 34, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- securely transmitting a payment from the transaction device to a vendor based on the embedded content through a transaction privacy clearing house (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 47, lines 4-63)

20. As per claims 20 and 35, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- transmitting the embedded content from the transaction device to a remote device (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5,

Art Unit: 3621

lines 1-41, column 17, lines 18-68, column 18, lines 1-65, column 40, lines 62-68, and column 41, lines 1-68).

21. As per claims 21, Ginter and Russo disclose all the limitations of claim 20, further;

Ginter discloses,

- locally verifying a permission to use the embedded content within the remote device; and
- utilizing the embedded content in response to the permission.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 17, lines 18-68, column 18, lines 1-65, column 40, lines 62-68, and column 41, lines 1-68).

22. As per claims 22 and 36, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- authenticating usage of the transaction device via a pin code (See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 40, lines 62-68, column 41, lines 1-68, and column 187, lines 10-47).

23. As per claims 26, 27, 28, and 40, Ginter and Russo disclose all the limitations of claims 14 and 29, further;

Ginter discloses,

- automatically calculating individual payments to multiple vendors based on the embedded content.
- providing the authorization in response to a local verification of sufficient funds within the transaction device.
- providing the authorization in response to a confirmed payment by the transaction device.

(See Ginter figures 5A, 5B and associated text, and column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 31, lines 6-26, column 40, lines 62-68, and column 41, lines 1-68).

24. As per claim 41, Ginter discloses a method comprising:

- transmitting embedded content from a first transaction device to a second transaction device;
- utilizing the embedded content on the second transaction device;
- storing a charge amount in the second transaction device in response to utilizing the embedded content on the second transaction device;
- automatically requesting a payment from the charge amount from the second transaction device to transaction clearing house subsequent to utilizing the embedded content within the second transaction device.

(See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

25. What is not specifically clear by Ginter is the utilization or availability of the content to the end user before the finalization of the verification of validity of charges. However, both Russo and Ginter clearly disclose similar systems of content distribution to the end user and making such content available to the end user without delay and charging happens after the content has been viewed or utilized substantially (See Russo column 5, lines 8-40, column 7, lines 43-63, column 10, lines 20-57, and column 11, lines 1-13). Russo is clear that content is available to the end user and the charges and accounting of such transaction happens within the end user's device (See Russo column 6, lines 16-61 and column 10, lines 19-57). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a more reliable and secure distribution system of content that the end user has more control on what they are paying for view before buy or try and buy systems, which are widely used in the digital works distribution industry. This actually speeds up the transaction in two fronts, first the end user is sure of what digital work is being obtained and second the accounting takes place at the end user device.

26. As per claim 42, Ginter and Russo disclose all the limitations of claim 41, further;

Art Unit: 3621

Ginter discloses,

- transmitting the payment from the second transaction device to the source through a secure financial transaction (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

27. As per claim 43, Ginter and Russo disclose all the limitations of claim 42, further;

Ginter discloses,

- wherein the secure financial transaction is routed through a transaction privacy clearing house transmitting the payment from the second transaction device to the source through a secure financial transaction (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 14, lines 25-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

28. As per claim 44, Ginter and Russo disclose all the limitations of claim 41, further;

Ginter discloses,

- further comprising utilizing the embedded content by the second transaction device (See Ginter column 3, lines 30-68, column 4, lines 1-68, column 5, lines 1-41, column 11, lines 58-68, column 12, lines 1-60, column 13, lines 5-68, column 14, lines 25-68, column 31, lines 6-26, column 40, lines 62-68, column 41, lines 1-68, column 47, lines 4-63, column 55, lines 61-68, and column 56, lines 1-64).

29. As per claims 23-25 and 37-39, Ginter and Russo disclose all the limitations of claims 14 and 29,

Ginter is not specific on disclosing the following,

- authenticating usage of the transaction device via a biometric parameter.
- the biometric parameter is a fingerprint.

Art Unit: 3621

- the biometric parameter is an iris scan,

Using authentication parameters in authorizing a user to access certain content or verifying business transactions is well known security practice within the art. To use biometric parameters as means of authentication within the art for high security access transactions is also well known. Few of the most prevalent biometric parameters used in the art are finger prints, voice prints, iris scan, and DNA samples. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the well-known practice of using biometric parameters as means of authentication of individual conduction a business transaction for better and higher security practice.

Conclusion

30. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3621

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

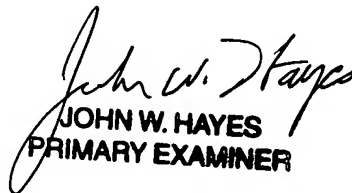
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
October 8, 2003**


**JOHN W. HAYES
PRIMARY EXAMINER**